

## **REMARKS**

### **I. Introduction**

With the cancellation herein without prejudice of claims 43, and 45, claims 26 to 42, 44 and 46 to 51 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants note with appreciation the acknowledgment of the claim for foreign priority and the indication that all copies of the certified copies of the priority documents have been received from the International Bureau.

Applicants thank the Examiner for considering the previously filed Information Disclosure Statement, PTO-1449 paper and cited references.

### **II. Objection to the Specification**

The objection to the Specification is not understood since the Specification was amended by the Preliminary Amendment filed on March 26, 2002. The Specification, as amended, does not include reference to claim numbers. In this regard, the Examiner's attention is directed to the Substitute Specification filed on March 26, 2002, which, pursuant to the Preliminary Amendment, replaced the Specification of record as originally filed. It is therefore respectfully submitted that this objection is moot, and withdrawal of this objection is respectfully requested.

### **III. Rejection of Claim 32 Under 35 U.S.C. § 112**

Claim 32 was rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite. While Applicant does not agree with the merits of this rejection, to facilitate matters, claim 32 has been amended herein without prejudice to recite:

the sensor carrier one of (a) formed and (b) aligned with respect to the main flow direction of the flowing medium so that a vector of the main flow direction one of (a) is in a plane of a sensor region of the sensor element and (b) intersects the plane of the sensor region at one of (a) a small positive and (b) a negative angle.

The foregoing amendments are believed to make even more clear the subject matter of claim 32. In view of the foregoing, withdrawal of this rejection is respectfully requested.

#### **IV. Allowable Subject Matter**

Applicants note with appreciation the indication of allowable subject matter contained in claims 40 and 41. In this regard the Examiner will note that claim 40 has been rewritten herein in independent form to include all of the limitations of its base claim and any intervening claims. It is therefore respectfully submitted that claim 40 is in condition for immediate allowance. Since claim 41 depends from claim 40, it is respectfully submitted that claim 41 is also in condition for immediate allowance.

#### **V. Rejection of Claims 26 to 31, 33 to 36, 38, 39 and 51 Under 35 U.S.C. § 102(b)**

Claims 26 to 31, 33 to 36, 38, 39 and 51 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,693,879 ("Rilling et al."). It is respectfully submitted that Rilling et al. do not anticipate the present claims as amended herein for at least the following reasons.

Claim 26 relates to a device for determining at least one parameter of a medium flowing in a line. As presented herein, claim 26 recites that the device includes: a sensor carrier including a sensor cavity; and at least one sensor element arranged on the sensor carrier in the sensor cavity, the sensor element configured to be introduced into the flowing medium and to determine the parameter. Claim 26 as presented herein further recites that the sensor carrier is a separate component secured in the device and that the sensor carrier is made of at least one of plastic and ceramic.

Rilling et al. purport to relate to a device 1 for measuring the mass of a flowing medium having a temperature-dependent sensor element 25, which is inserted flush into a recess 58 of a sensor carrier 27. See Abstract; Figures 1 to 5. It is respectfully submitted that Rilling et al. do not describe, or even suggest, a sensor carrier that is made of plastic and/or ceramic, as recited in claim 26. Instead, Rilling et al. disclose that the sensor carrier 27 is made by bending a thin metal strip. See Abstract; col. 4, lines 38 to 39. Indeed, the Office Action admits on page 3 that Rilling et al. "[are] not specific as to the carrier itself being made from plastic or ceramic." Accordingly, since Rilling et al. do not identically disclose, or even suggest, all of the limitations of claim 26, it is respectfully submitted that Rilling et al. do not anticipate claim 26.

As regards to claims 27 to 31, 33 to 36, 38, 39 and 51, which ultimately depend from claim 26 and therefore include all of the limitations of claim 26, it is respectfully submitted that Rilling et al. do not anticipate these dependent claims for at least the same reasons given above in support of the patentability of claim 26.

In view of the foregoing, withdrawal of this rejection is respectfully requested.

**VI. Rejection of Claims 32, 37 and 42 to 50 Under 35 U.S.C. § 103(a)**

Claims 32, 37 and 42 to 50 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Rilling et al. and U.S. Patent No. 6,253,606 ("Yonezawa"). Applicants respectfully submit that the combination of Rilling et al. and Yonezawa et al. does not render unpatentable the present claims for the following reasons.

As an initial matter, claims 43 and 45 have been canceled herein without prejudice, thereby rendering moot the present rejection with respect to claims 43 and 45.

Claims 32, 37, 42, 44 and 46 to 50 ultimately depend from claim 26 and therefore include all of the limitations of claim 26. As more fully set forth above, Rilling et al. do not disclose, or even suggest, all of the limitations of claim 26. Yonezawa et al. are not relied on for disclosing or suggesting the limitations of claim 26 not disclosed or suggested by Rilling et al. Indeed, it is respectfully submitted that Yonezawa et al. do not disclose, or even suggest, the limitations of claim 26 not disclosed or suggested by Rilling et al.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d

981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Since the combination of Rilling et al. and Yonezawa et al. fails to disclose, or even suggest, all of the limitations of claim 26, as more fully set forth above, it is respectfully submitted that the combination of Rilling et al. and Yonezawa et al. does not render obvious claims 32, 37, 42, 44 and 46 to 50, which ultimately depend from claim 26. In re Fine, *supra* (any dependent claim that depends from a non-obvious independent claim is non-obvious).

Moreover, the assertions on page 3 of the Office Action that "Rilling teaches the device as having parts made from plastic and carrier formed of a substrate" and that "it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use plastic or ceramic as a carrier element since it is very well known in the flow measuring art where such material is used in order to provide a cost effective device and also capable of withstanding the heat" constitute nothing more than pure speculation and conjecture, represent nothing more than mere hindsight reasoning and are apparently improperly based on information other than that which is disclosed by Rilling et al. In particular, Rilling et al. merely describe the use of plastic for housings of the device 1 (e.g., base housing 15, cover 80, and closure cap 28). Furthermore, it is respectfully submitted that those skilled in the art would consider metal much more suitable in its ability to withstand heat as compared to plastic, and that the use of plastic or ceramic rather than metal for the sensor carrier 27 of the device 1 would introduce an additional concern of varying thermal expansion of the sensor carrier 27 with respect to other components. Accordingly, the assertions contained in the Office Action appear to be based on personal knowledge on the part of the Examiner. In this regard, if the rejection is based on facts within the Examiner's personal knowledge, Applicants respectfully request that the Examiner provide Applicants with an affidavit under 37 C.F.R. § 1.104(d)(2). See, e.g., M.P.E.P. § 2144.03. Nevertheless, Applicants respectfully traverse all assertions of well known fact and request that the Examiner provide published information or other evidence as to these assertions.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

**VII. Conclusion**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

KENYON & KENYON

Dated: July 19, 2004

By: Richard L. Mayer  
Richard L. Mayer  
Reg. No. 22,490  
B.no.  
42,194

One Broadway  
New York, New York 10004  
(212) 425-7200

**CUSTOMER NO. 26646**